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BRINKS HOFER GILSON & LIONE
P O BOX 10395
CHICAGO, IL 60610

EXAMINER

COLON, CATHERINE M

ART UNIT PAPER NUMBER

3623

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,611

Applicant(s)

PERRY ET AL.

Examiner

C. Michelle Colon

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 4, 2004 has been entered.

Claims 1, 6, 8, 9, 12, 13, 15, 20, 22, 27, 30-34 and 38 have been amended.
Claims 1-38 are now pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-17, 22 and 32-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 15 recite the limitation, "the structures." There is insufficient antecedent basis for this limitation in the claims. More specifically, as per claim 1, it is unclear if "structures" is referring to the proposals or to the components that the proposal comprises such as an alliance, acquisition, equity venture, partnership or venture. The first mention of structure in claim 1 is used as a verb. Since the second mention of structure in claim 1 is a noun, it is unclear what is considered a structure.

Claim 1 is also vague and indefinite for its multiple uses of the word, information. The claim recites, "gathering information" on a proposal in the first limitation, "accessing information" on *other* proposals in the second limitation, and "evaluating the information" in the third limitation. It is unclear if the information gathered on other proposals comprises the same information as defined in the first limitation. It is also unclear whether the evaluation is occurring on the information gathered from both the first *and* second limitations.

Since claim 1 is unclear about what type of information is being used when (i.e., since claim 1 does not expressly recite which information is evaluated by the computer and does not even correlate the evaluation of the information to the ranking of the structures), it raises issues of recitation of nonfunctional descriptive material in the claim. As per MPEP § 2106, nonfunctional descriptive material includes but is not limited to music, literary works and a compilation or mere arrangement of data. Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. Therefore, the nonfunctional descriptive material does not hold any patentable weight. However, nonfunctional descriptive material may be claimed in combination with other functional descriptive

multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of the above 35 U.S.C. 112, second paragraph rejection. Therefore, claim 1 would eliminate nonfunctional descriptive material issues if it more clearly recited which gathered information is accessed and evaluated and further, if it more clearly correlated the evaluating and ranking steps.

Claims 32-38 contain similar nonfunctional descriptive material issues as claims 1-3 and 5-17 since claim 32 recites a list of components for the data but nowhere in the claims uses the data for any functionality such as calculation and analysis.

Claim 22 is vague and indefinite because it provides an intended field of use recitation, "for use by the computer in calculating the advantage of the structure," but, does not set forth any steps positively reciting the method/process. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Objections

4. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 2 recites, "...wherein information gathering further comprises at least one of...methods of achievement of the proposal." However, the information gathering in claim 1 already

comprises methods of achievement of the proposal. Since claim 2 only asks for at least one of the data, it is feasible that claim 2 would not further limit claim 1 if the information gathered in claim 2 was only methods of achievement of the proposal.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-7, 10-14, 16-21, 25-33, 35, 36 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Wright et al. (U.S. 6,581,040).

As per claim 1, Wright et al. discloses a method of evaluating a business proposal, comprising the steps of:

gathering information on the proposal, wherein the information comprises revenue elements of the proposal, risks, descriptive information, business issues, business goals, a value of the proposal, a cost of the proposal, methods of achievement of the proposal, and an innovation value of the proposal, and wherein the proposal is structured as two or more of an alliance, an acquisition, an equity venture, a partnership, and a venture (col. 2, lines 39-58; col. 3, lines 51-55; col. 4, lines 39-59; col. 5, lines 45-col. 6, line 37; col. 7, lines 29-60; col. 8, lines 7-30; col. 8, line 62-col. 9,

line 18; The system gathers information on proposals submitted by resource providers for projects.);

accessing information on similar or analogous proposals (col. 4, lines 39-59; col. 5, lines 45-col. 6, line 37; col. 7, lines 29-60; col. 8, lines 7-30; col. 8, line 62-col. 9, line 18; Figure 3);

evaluating the information by computer (col. 4, lines 54-59; Project owners review bids/proposals for projects before selecting a resource provider.); and

ranking the structures (col. 7, lines 23-27; col. 9, lines 19-25; The system has an internal sorting function for data submitted.).

As per claim 2, Wright et al. discloses the method of claim 1, wherein information gathered further comprises at least one of business environmental information, business issues and goals, financial information, and methods of achievement of the proposal (col. 10, lines 3-39).

As per claim 3, Wright et al. discloses the method of claim 1, wherein the information gathering step further comprises answering predetermined questions on at least one template stored in a computer and the answers to at least one predetermined question call up at least one more template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal (col. 6, lines 17-30; col. 7, line 61-col. 8, line 59; col. 11, lines 25-67; The system uses templates to facilitate communication between project owners and resource providers.).

As per claim 4, Wright et al. discloses the method of claim 1, wherein the proposals are evaluated by calculating at least one of a cost, a revenue stream, a return

on average assets, a return on investment, a return on equity, and internal rate of return, and a net present value (col. 9, line 46-col. 10, line 2; Proposals are evaluated based on a variety of criteria including cost.).

As per claim 5, Wright et al. discloses the method of claim 1, further comprising evaluating risks of the proposal as high or normal (col. 9, lines 19-25).

As per claim 6, Wright et al. discloses the method of claim 1, further comprising choosing an input into the computer by a radio-button technique (col. 10, lines 3-55; The system provides a web interface for users to interact with the system.).

As per claim 7, Wright et al. discloses the method of claim 1, further comprising displaying the rankings with a graphical user interface (col. 10, line 56-col. 11, line 51; The system sorts data based on criteria and then displays the data for particular users.).

As per claim 10, Wright et al. discloses the method of claim 1, wherein the cost of the proposal is calculated as a revenue stream to a service provider (col. 9, lines 46-53).

As per claim 11, Wright et al. discloses the method of claim 10, further comprising the steps of calculating a benefit to the customer of providing said service to said customer (col. 8, lines 23-49; Resource providers are able to convey their capabilities and service offerings by using templates that match the resource providers to projects.).

As per claim 12, Wright et al. discloses the method of claim 1, wherein the information is input to the computer through a graphical user interface by choosing selections from at least one of a drop-down screen, a scroll screen, a check box, and a

list box (col. 10, lines 3-55; The system provides a web interface for users to interact with the system.).

As per claim 13, Wright et al. discloses the method of claim 12, wherein the graphical user interface uses a technique selected from the group consisting of a drop-down screen, a scroll screen, a check box, and a list box (col. 10, lines 3-55; The system provides a web interface for users to interact with the system.).

As per claim 14, Wright et al. discloses the method of claim 1, wherein the proposal comprises an offer of a service from a provider, and further comprising the step of calculating a way to pay for the proposal (col. 9, lines 46-67).

As per claim 16, Wright et al. discloses the method of claim 1, wherein the information is provided through a graphical user interface, and the input is in a form of brief numerical or pseudo-numerical outputs (col. 9, lines 46-67; The resource providers formulate price quotes for one or more projects. Price quotes are a numerical form.).

As per claim 17, Wright et al. discloses the method of claim 1, wherein an output is provided through a graphical user interface, and the output is in a form of brief numerical or pseudo-numerical outputs (col. 9, lines 46-67; The resource providers formulate price quotes for one or more projects. Price quotes are a numerical form.).

As per claim 18, Wright et al. discloses a method of evaluating a business proposal, comprising:

searching at least one database for information concerning a business partner, the proposal and a business environment, wherein the information includes cost drivers, revenue drivers, markets served, risks of the proposal, customers served, and a

competitive advantage (col. 4, lines 32-59; col. 5, lines 45-67; col. 7, lines 29-67; col. 8, lines 7-30; col. 8, line 62-col. 9, line 18; The system gathers information on proposals submitted by resource providers for projects.);

providing financial data concerning the proposal to a computer, wherein the financial data includes revenue elements of the proposal, a cost of the proposal, and an innovation value of the proposal (col. 9, lines 46-67; col. 16, lines 7-9);

proposing at least two structures for the business proposal, using said financial data and information from the database, wherein the structures are selected from the group comprising of an alliance, an acquisition, an equity venture, a partnership, and a venture (col. 2, lines 39-58; col. 3, lines 51-55; col. 6, lines 3-37; col. 8, line 62-col. 9, line 18); and

calculating an advantage of the structures (col. 7, lines 23-27; col. 9, lines 19-25; The system has an internal sorting function for data submitted and rates resource providers.).

As per claim 19, Wright et al. discloses the method of claim 18, wherein the database comprises a client relationship repository of information (col. 7, lines 20-28 and 54-65).

As per claim 20, Wright et al. discloses the method of claim 18, further comprising evaluating risks of the proposal as high or as normal and receiving an input of a risk evaluation through a graphical user interface (col. 9, lines 19-25; The system allows users to evaluate the suitability of resource providers with certain projects. The resource providers are evaluated on capabilities, ratings and preferences.).

As per claim 21, Wright et al. discloses the method of claim 18, wherein the step of providing financial data comprises retrieving financial data from at least one database (col. 9, lines 9-38; Resource providers provide information on bids and proposals to the database.).

As per claim 25, Wright et al. discloses the method of claim 18, wherein the advantage is calculated as at least one of a cost, a revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present value (col. 7, lines 23-27; col. 9, lines 19-25; The system has an internal sorting function for data submitted and rates resource providers based on capabilities and preferences.).

As per claim 26, Wright et al. discloses the method of claim 18, wherein the advantage is calculated as at least one revenue stream and includes an example of how to pay for the service (col. 7, lines 23-27; col. 9, lines 19-25 and lines 46-67).

As per claim 27, Wright et al. discloses the method of claim 18, further comprising the step of ranking each structure (col. 7, lines 23-27; col. 9, lines 19-25; The system has an internal sorting function for data submitted.).

As per claim 28, Wright et al. discloses the method of claim 18, wherein the advantage is recalculated by a step of entering updated data into the computer (col. 7, lines 54-60).

As per claim 29, Wright et al. discloses the method of claim 18, wherein the step of searching comprises a search of at least one Internet site, and further comprising the

steps of updating the search periodically, and updating the computer calculation of an advantage periodically (col. 10, lines 40-49).

As per claim 30, Wright et al. discloses the method of claim 18, wherein the information is provided through a graphical user interface (col. 10, lines 40-67).

As per claim 31, Wright et al. discloses the method of claim 18, further comprising a step of providing an output through a graphical user interface (col. 10, lines 40-67; Figure 5).

As per claim 32, Wright et al. discloses a computer system for evaluating a proposal, comprising:

a computer processor (col. 10, lines 3-25);
at least one memory operably connected to said computer, said memory containing data relevant to the proposal, wherein the data comprises revenue elements of the proposal, risks, descriptive information, business issues, business goals, a value of the proposal, a cost of the proposal, methods of achievement of the proposal, and an innovation value of the proposal (col. 2, lines 39-58; col. 3, lines 51-55; col. 4, lines 39-59; col. 5, lines 45-col. 6, line 37; col. 7, lines 29-60; col. 8, lines 7-30; col. 8, line 62-col. 9, line 18; The system gathers information on proposals submitted by resource providers for projects.); and

a computer program for evaluating the proposal, said program residing in said computer or in said memory, wherein the proposal includes a plurality of structures selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture, and computer program calculates an output helpful for

evaluating the plurality of structures (col. 4, lines 54-59; col. 7, lines 23-27; col. 9, lines 19-25; Project owners review bids/proposals for projects before selecting a resource provider. The system utilizes an internal sorting function to evaluate the resource providers.).

As per claim 33, Wright et al. discloses the computer system of claim 32, wherein the computer program further comprises a graphical user interface for at least one of inputting or outputting information (col. 10, lines 40-67; Figure 5).

As per claim 35, Wright et al. discloses the computer system of claim 32, wherein the computer program further comprises at least one template of predetermined questions, and the computer program uses the answers to said questions to evaluate the proposal (col. 6, lines 17-30; col. 7, line 61-col. 8, line 59; col. 11, lines 25-67; The system uses templates to facilitate communication between project owners and resource providers.).

As per claim 36, Wright et al. discloses the computer system of claim 32, wherein the answers to at least one predetermined question call up at least one more template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal (col. 6, lines 17-30; col. 7, line 61-col. 8, line 59; col. 11, lines 25-67; The system uses templates to facilitate communication between project owners and resource providers.).

As per claim 38, Wright et al. discloses the computer system of claim 32, wherein the computer program uses a technique of control-action-response in seeking and inputting information from a user of the computer system (col. 9, line 39-col. 10, line 49;

col. 11, lines 11-48; The system uses extensive communication services that allow users to seek and share information.).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8, 9, 15, 22-24, 34 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al. (U.S. 6,581,040) as applied above.

As per claims 8 and 37, Wright et al. does not expressly disclose the method and computer system of claims 7 and 32, wherein the rankings are presented in a Harvey-ball format. The Harvey-ball format is an old and well known display format that uses moon phases to indicate association levels of an item based on certain criteria. The Harvey-ball format provides a quick and easy way for a user to view compare items based on certain criteria. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to display rankings of items using a Harvey-ball format because such a display would provide users with a quick and easy means for assessing the rankings.

As per claims 9 and 15, Wright et al. does not expressly disclose the method of claim 1, wherein the rankings are displayed in a graphical user interface in a numerical format. However, numerical formats for displaying rankings are old and well known in

the art. Numerical formats also provide a quick and easy way for a user to view compare items based on certain criteria. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to display rankings using a numerical format because such a display would provide users with a quick and easy means for assessing the rankings.

As per claims 22 and 34, Wright et al. does not expressly disclose the method and computer system of claims 18 and 32, further comprising the step of entering information concerning strength of a business relationship by entering a number from 1 to 5, for use by the computer in calculating the advantage of the structure. However, Wright et al. does disclose that information such as capabilities, ratings and preferences are used to evaluate resource providers for projects and to assess which resource providers would compliment each other on a project (col. 9, lines 19-45). Assessing whether vendors would compliment each other on a project is a form of measuring the strength of a business relationship. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to use numbers from 1 to 5 to indicate the strength of a business relationship because doing so provides a quantitative assessment that is easy for users to comprehend.

As per claim 23, Wright et al. discloses the method of claim 22, wherein the information is entered through at least one template stored in a computer (col. 5, lines 45-67; col. 6, lines 17-30).

As per claim 24, Wright et al. discloses the method of claim 23, wherein the information entered through at least one template calls up at least one template of

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predetermined questions, and the computer uses answers to said questions to evaluate the proposal (col. 5, lines 45-67; col. 6, lines 17-30; col. 7, line 66-col. 8, line 59).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Wares (Pub. No. US 2001/0044768) discusses an e-commerce bid and project management system;
- Livesay et al. (Pub. No. US 2002/0046147) discusses a process for providing data and comparing proposals; and
- Thackston (U.S. 6,295,513) discusses a collaborative environment for the manufacture of parts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 703-605-4251. The examiner can normally be reached Monday – Thursday from 8:30am to 5:30pm and every other Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 703-305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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Any response to this action should be mailed to:

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703-746-7202 [For status inquiries, draft communication, labeled
"Proposed" or "Draft"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA 7th floor receptionist.


cmc

April 9, 2004


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3500